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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,158	06/27/2000	Steven M. Bessette	45112-085	5507

7590 06/03/2003

McDermott Will & Emery
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EXAMINER

PATTEN, PATRICIA A

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,158

Applicant(s)

Bessette, S.M.

Examiner

Patricia Patten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 30, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7, 11-13, and 16-33 is/are pending in the application.
- 4a) Of the above, claim(s) 7, 12, 13, and 16-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

RCE Practice

A request for continued examination under 37 CFR § 1.114, including the fee set forth in 37 CFR § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR § 1.114, and the fee set forth in 37 CFR § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR § 1.114. Applicant's submission filed on 10/11/02 has been entered.

Election/Restriction

Applicant's election with traverse of Group I, claims 1 and 11 in Paper No. 15 is acknowledged. The traversal is on the ground(s) that the search for the inventions would necessarily overlap and would not pose a serious burden on the Examiner. This is not found persuasive because, as evidenced *infra*, a search for the elected invention did not bring about the compositions of claims 7 or 13 for example, or a composition of any of the independent claims 16, 18, 22, 26, 28 and 31. All of these groups are

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patentably distinct compositions and would require separate searches in the patented as well as non-patent literature.

The requirement is still deemed proper and is therefore made FINAL. Claims 7, 12, 13 and 16-33 have been withdrawn from further consideration on the merits as being drawn to a non-elected invention.

Claims 1 and 11 were examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claim 1 remains rejected under 35 U.S.C. 102(e) as being anticipated by Bessette et al. (US 6,183,767) for the reasons set forth in the Final office action.

Applicant's arguments were fully considered, but not found convincing.

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Applicant contends that Besette et al. ('767) does not anticipate the claimed invention, in that '767 only disclose the compositions for controlling spider mites. In the Instant case, the Intended use of the Instant claim is not given much patentable weight; i.e., 'for the control of house dust mites'. Although Besette et al. did not explicitly teach that the composition was useful for controlling dust mites, the composition was nevertheless the same composition as recited in the Instant claims. It is deemed that controlling dust mites would have therefore been an inherent property of the composition lacking sufficient evidence to the contrary. Applicant is asked to review In re Hack, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957). "When the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated" (MPEP 2100 pp. 2113).

Claim Rejections - 35 USC § 103

Claims 1 and 11 are newly rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. (US 6, 130,253) in view of Wolf et al. (EP 475253 A2).

Franklin et al. (US 6, 130,253) taught that a composition comprising citral was effective in killing house dust mites (lotion formulation col.35, line 56- col.36 line 9 and

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Table 11). Franklin et al. did not specifically teach where another active ingredient as recited in the Instant claims was added into the composition.

Wolf et al. (EP 475253 A2) disclosed that menthol compounds, preferably prepared with a carrier, were useful for controlling dust mites (English Abstract).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine citral and menthol for their known benefit since each was well known in the art for controlling dust mites. This rejection is based on the well established proposition of patent law that **no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients**, *In re Sussman*, 1943 C.D. 518 (emphasis added). Any mixture of the components embraced by the claims which does not exhibit an unexpected result (e.g., synergism) is therefore *ipso facto* obvious.

Accordingly, the instant claims, in the range of proportions where no unexpected results are observed, would have been obvious to one of ordinary skill having the above cited references before him.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed

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invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

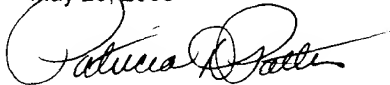
No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback is on 703-306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

May 29, 2003

A handwritten signature in black ink, appearing to read 'Patricia Patten', with a stylized flourish extending from the end.

Patricia Patten